

REMARKS

Reconsideration of the application in view of the above amendments and the following remarks is respectfully requested. Claims 6, and 22 have been amended, and Claims 7, and 23 have been canceled. No claims have been added. Claims 1-6, 8-22, and 24-32 are currently pending in the application.

Claim Rejections – 35 U.S.C. § 112

In the Office Action, the Examiner rejected Claims 6, 7, 22, and 23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claims 6 and 22 have been amended. Claims 7 and 23 have been canceled.

In the rejection, the Examiner stated that, when applying the transformation document to a first document, because the particular data structure pattern is not in the first document, the non-match template will never be invoked. It appears that the Examiner is concerned about the “when invoked” language of the claims, which implies that the non-match template will be invoked. To address this concern, Claims 6 and 22 have been amended to change “when invoked” to “if invoked” to take into account the possibility that the non-match template may never be invoked. Applicant believes that this amendment cures any alleged defect in the claims. Of course, it should be noted that the non-match template could be invoked. For example, if a user inserts a triggering data structure pattern into the non-match template, and that triggering data structure pattern is encountered during processing of a document, the non-match template will be invoked. The “if invoked” language takes into account both possibilities. Applicant submits that Claims 6 and 22 as amended comply with 35 U.S.C. § 112, first paragraph. Hence, Applicant requests that this rejection be withdrawn.

In the Office Action, the Examiner rejected Claims 6, 7, 22, and 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Because the Examiner provided the same reasoning in rejecting Claims 6, 7, 22, and 23 under 35 U.S.C. § 112(2) as the Examiner did in rejecting the same claims under 35 U.S.C. § 112(1), Applicant believes the arguments set forth above equally apply to this rejection. Hence, the withdrawal of this rejection is also requested.

Claim Rejections – 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected Claims 1-8, 14-24, and 30-32 under 35 U.S.C. § 102(e) as being anticipated by Worden (U.S. 2003/0149934 A1, filed 05/2001). This rejection is respectfully traversed.

Independent Claim 1

With regard to independent Claim 1, there is recited:

A computer-implemented method for generating a transformation document, comprising:
analyzing a first document;
analyzing a second document; and
automatically generating, based upon said first and second documents, a transformation document which, when processed in conjunction with said first document, gives rise to a result document that is at least an approximation of said second document (emphasis added).

Claim 1 provides an advantageous method for automatically generating a transformation document. According to Claim 1, a computer-implemented method analyzes a first document and a second document and automatically generates, based upon the first and second documents, a transformation document that can be processed in conjunction with the first document to provide a result document that is at least an approximation of the second document. Traditionally, transformation documents were

produced manually; however, with the method of Claim 1, these transformation documents can now be generated automatically, based upon a first and second document.

Such a method is neither disclosed nor suggested by Worden. Instead, in the sections cited by the Examiner, Worden discloses a method for using a set of mappings between two XML based languages to generate XSLT, which is then used to translate a document in the first XML based language to a document in the second XML based language (Page 3, para. 39).

While Worden addresses the generally similar subject matter of document transformations, it should be noted that Worden approaches the subject matter from a different angle than that of Claim 1. As discussed above, Worden teaches a method in which, given a set of mappings between two XML based languages, an XSLT document is derived, which can then be applied to translate a document in the first language to a document in the second language. Thus, Worden starts with a set of mappings between two XML based languages and then generates XSLT. In sharp contrast, the method of Claim 1 discloses a different process in which the first and second documents are initially provided. Based on the first and second documents, as opposed to a set of mappings between two languages, the method of Claim 1 automatically generates a transformation document. Once generated, the transformation document can be processed with the first document to derive a result document that at least approximates the second document. Thus, in Claim 1, the method starts with first and second documents and generates a transformation document therefrom. From this discussion, it is clear that the methods are very different. Nowhere in Worden is it disclosed or suggested that a transformation document be automatically generated based upon first and second documents.

In rejecting Claim 1, the Examiner does not make it clear what components of Worden are being interpreted as the first and second documents of Claim 1. In Applicant's view, there are two possible interpretations: 1) the first XML language of Worden is the first document of Claim 1 and the second XML language of Worden is the second document of Claim 1; or 2) the document in the first XML language of Worden is the first document of Claim 1 and the document in the second XML language of Worden is the second document of Claim 1. Under either interpretation, Worden does not read on Claim 1.

Under the first interpretation, it should be noted that the first and second XML languages of Worden can in no way be interpreted as "documents". Rather, an XML language is, by its name, a language, not a document. Additionally, even if the first XML language of Worden could be interpreted as the first document of Claim 1 and the second XML language of Worden could be interpreted as the second document, Worden would still not read on claim 1. Claim 1 requires that when the transformation document is processed in conjunction with the first document, a result document is produced which is at least an approximation of the second document. In Worden, the XSLT document is never processed in conjunction with the first XML language to produce a result document. In addition, even if the XSLT document were processed in conjunction with the first XML language, it would certainly not produce anything that approximates the second XML language. That is simply not the purpose of Worden's XSLT document. Thus, for at least this reason, Applicant submits that Worden does not disclose or suggest Claim 1 under the first interpretation.

According to the second interpretation, a document in the first XML language of Worden is the first document of Claim 1 and a document in the second XML language of Worden is the second document of Claim 1. Under this interpretation, Worden clearly does not read on Claim 1. This interpretation has at least two problems. First, Claim 1 requires that the transformation document be generated based upon the first and second documents, which means that the first and second documents need to be analyzed before the transformation document is automatically generated. In contrast, Worden teaches that the document in the first XML language and the document in the second XML language are not even considered until after the XSLT document is generated. In fact, the document in the second XML language is not even produced until after the XSLT is applied to the document in the first XML language. Thus, it is not possible for the document in the second XML language to be analyzed before the XSLT document is generated. This production order also leads into the second point, which is that Claim 1 requires the transformation document to be generated based upon the first and second documents. As argued above, the document in the second XML language of Worden is not even produced until after the XSLT document is applied to the document in the first XML language. Thus, there is no way that the XSLT document of Worden could be generated based upon the document in the second XML language. For at least these reasons, Applicant submits that Worden does not disclose or suggest Claim 1 under the second interpretation.

As argued above, Worden neither discloses nor suggests the automatic generation of a transformation document based upon a first document and a second document, as recited in Claim 1. Therefore, Applicant submits that Claim 1 is patentable over Worden.

Applicant further submits that dependent Claims 2-8, and 14-16, which depend from Claim 1 and which recite further advantageous aspects of the invention, are likewise patentable over Worden for at least the reasons given above in connection with Claim 1.

Claims 17-24, and 30-32 include limitations similar to Claims 1-8, and 14-16, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 17-24, and 30-32 are patentable over Worden for at least the reasons given above with respect to Claims 1-8, and 14-16.

Claim Rejections – 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 9-11 and 25-27 under 35 U.S.C. § 103(a) as being unpatentable over Worden as applied to Claims 1 and 17 above, and further in view of Wheeler et al. (U.S. 2002/0055932 A1, filed 08/06/2001). This rejection is respectfully traversed.

For the sake of argument, it will be assumed that Wheeler discloses the subject matter as contended by the Examiner, and that it would have been obvious to combine the references. Even if this were true, however, the combination of Worden and Wheeler still would not produce the method of Claims 9-11. As argued above in connection with Claim 1 (from which Claims 9-11 depend), Worden fails to disclose or suggest a number of aspects of Claim 1, such as automatically generating a transformation document based upon first and second documents. Wheeler et al. has the same deficiencies. Therefore, even if the references were combined, they still would not disclose every element of Claim 1. Thus, Applicant submits that Claim 1 is patentable over Worden and Wheeler et al., taken individually or in combination. Applicant further submits that Claims 9-11, which depend from Claim 1, and which recite further advantageous aspects of the

invention, are likewise patentable over Worden and Wheeler et al. for at least the reasons given above in connection with Claim 1.

Claims 25-27 include limitations similar to Claims 9-11, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 25-27 are patentable over Worden and Wheeler et al. for at least the reasons given above with respect to Claims 9-11.

In the Office Action, the Examiner rejected Claims 12 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Worden further in view of Wheeler as applied to Claims 11 and 27 above, and further in view of Weinberg et al. (U.S. 2002/0194196 A1, priority filed 10/2000). This rejection is respectfully traversed.

For the sake of argument, it will be assumed that Wheeler et al. and Weinberg et al. disclose the subject matter as contended by the Examiner, and that it would have been obvious to combine the references. Even if this were true, however, the combination of Worden, Wheeler et al., and Weinberg et al. still would not produce the method of Claim 12. As argued above in connection with Claim 1 (from which Claim 12 depends), Worden fails to disclose or suggest a number of aspects of Claim 1, such as automatically generating a transformation document based upon said first and second documents. Wheeler et al. and Weinberg et al. have the same deficiencies. Therefore, even if the references were combined, they still would not disclose every element of Claim 1. Thus, Applicant submits that Claim 1 is patentable over Worden, Wheeler et al., and Weinberg et al., taken individually or in combination. Applicant further submits that Claim 12, which depends from Claim 1, and which recites further advantageous aspects of the

invention, is likewise patentable over Worden, Wheeler et al., and Weinberg et al. for at least the reasons given above in connection with Claim 1.

Claim 28 includes limitations similar to Claim 12, except in the context of computer-readable media. It is therefore respectfully submitted that Claim 28 is patentable over Worden, Wheeler et al., and Weinberg et al. for at least the reasons given above with respect to Claim 12.

In the Office Action, the Examiner rejected Claims 13 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Worden as applied to Claims 1 and 17 above, and further in view of Wheeler et al. (U.S. 2002/0055932 A1, filed 08/06/2001) and Menke (U.S. 2002/0123878 A1, filed 02/2001). This rejection is respectfully traversed.

For the sake of argument, it will be assumed that Wheeler et al. and Menke disclose the subject matter as contended by the Examiner, and that it would have been obvious to combine the references. Even if this were true, however, the combination of Worden, Wheeler et al., and Menke still would not produce the method of Claim 13. As argued above in connection with Claim 1 (from which Claim 13 depends), Worden fails to disclose or suggest a number of aspects of Claim 1, such as automatically generating a transformation document based upon said first and second documents. Wheeler et al. and Menke have the same deficiencies. Therefore, even if the references were combined, they still would not disclose every element of Claim 1. Thus, Applicant submits that Claim 1 is patentable over Worden, Wheeler et al., and Menke, taken individually or in combination. Applicant further submits that Claim 13, which depends from Claim 1, and which recites further advantageous aspects of the invention, is likewise patentable over



Worden, Wheeler et al., and Menke for at least the reasons given above in connection with Claim 1.

Claim 29 includes limitations similar to Claims 13, except in the context of computer-readable media. It is therefore respectfully submitted that Claim 29 is patentable over Worden, Wheeler et al., and Menke for at least the reasons given above with respect to Claim 29.

Conclusion

For the reasons given above, Applicant submits that the pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all pending claims is respectfully solicited.

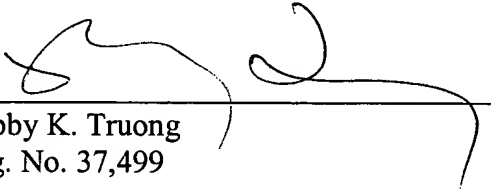
The Examiner is invited to telephone the undersigned at (408) 414-1080 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Reply. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: August 16, 2004


Bobby K. Truong
Reg. No. 37,499

1600 Willow Street
San Jose, California 95125-5106
Telephone No.: (408) 414-1080
Facsimile No.: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

on August 16, 2004

by 